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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,246	11/24/2003	James Say	TS-02-18	6045

30349 7590 10/12/2006

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OAKLAND, CA 94611-2802

EXAMINER
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NATNITHITHADHA, NAVIN

ART UNIT	PAPER NUMBER
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3735

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/722,246

Applicant(s)

SAY ET AL.

Examiner

Navin Natnithithadha

Art Unit

3735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 11, 14, 15, 24, and 30 have been amended. Claims 1-10 have been cancelled. Claims 11-30 are pending.
2. The 35 U.S.C. 112, first paragraph, rejections to claims 11-23 are WITHDRAWN in view of the Amendment.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 11-30 as rejected under 35 U.S.C. 102(e) by Gross et al, US 6,275,717 B1 ("Gross") have been considered but are moot in view of the new ground(s) of rejection.
4. Applicant's arguments with respect to claims 24-30 as rejected under 35 U.S.C. 102(e) by Gross et al, US 5,800,420 A ("Gross '420") have been considered but are moot in view of the new ground(s) of rejection.
5. Applicant's arguments, see Remarks, filed 28 June 2006, with respect to claims 11-23 have been fully considered and are persuasive. The rejection under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,175,752 B1 in view of Gross of claims 11-23 has been withdrawn.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 11-18 and 20-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Shichiri et al, EP 0098592 ("Shichiri").

Claim 11-18 and 20-22: Shichiri teaches a sensor control system (see figs. 1 and 2), comprising: an electrochemical analyte sensor (electrode means including a needle electrode) 13; a mounting unit 12; and a housing (watch-shaped transmitting assembly) 2 attached or mounted to the removable mounting unit (belt) 12, the housing 12 including a transmitter unit 11 for wirelessly transmitting data to a receiver 5, e.g. infusion device/insulin pump 28, for receiving data (see fig. 1A and 1B).

Claims 23-30: Shichiri teaches a method of using the sensor control system in Figures 1 and 2, comprising: transcutaneously positioning an electrochemical sensor 13 in a patient (see fig. 1); attaching a mounting unit 12 onto the skin of the patient (see fig. 1); and operatively coupling a housing 2 including a wireless transmitter unit 23 to the mounting unit 12 so that the wireless transmitter unit 23 is configured for electrical communication with the sensor (housing 2 is connected to the sensor 13, thus communicates with the sensor 13); detecting (using electrode 13) and transmitting (using transmitter unit 11) the signal representative of the analyte level.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shichiri, as applied to claim 11 above, and further in view of Gross et al, US 5,800,420 A ("Gross").

Claim 19: Shichiri does not teach an adhesive layer disposed on a surface of the mounting unit and an opening configured to receive a portion of the sensor extending from the skin of the patient. However, Gross teaches a system comprising: an adhesive layer disposed on a surface of a mounting unit (first part) 52 (see col. 17, ll. 66-67). Thus, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Shichiri's mounting unit (belt) 12 to have an adhesive

layer in order to provide stability to the housing 2, thus decreasing error in the electrode measurement of glucose concentration.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Navin Natnithithadha whose telephone number is (571) 272-4732. The examiner can normally be reached on Monday-Friday, 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Navin Natnithithadha  
Patent Examiner – GAU 3735  
02 October 2006